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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,387	12/29/2003	D. Clayton Evans	PU2199	8163

7590 06/15/2004

Callaway Golf Company
2180 Rutherford Road
Carlsbad, CA 92008

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/748,387	Applicant(s) EVANS, D. CLAYTON	
	Examiner Sebastiano Passaniti	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is responsive to communication received 12/29/2003 – application papers filed.

This application is a continuation of 10/064,810, filed 08/20/2002, now U.S. Patent 6,669,578, which is a continuation-in-part of 10/064,434, filed 06/12/2002, now U.S. Patent 6,648,773.

Claims 1-3 are pending.

Following is an action on the MERITS:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,669,578 in view of Peterson. The claims of the '578 Patent differ from the claims of the instant application in that the claims of the '578 Patent require a striking plate fabricated from an amorphous metal material and a club body composed of plies of pre-peg material. The instant claims, on the other hand, require a body of non-metal

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material and do not specifically set forth the material make-up of the striking face. The teaching reference to Peterson details that the reinforced club head structure may be formed from any one of titanium, aluminum, stainless steel, composite or amorphous materials. See col. 4, lines 49-62 in Peterson. In view of the patent to Peterson, it would have been obvious to modify the claimed device of the '578 Patent by fashioning the body from any conveniently available material such as a non-metallic material to make use of the desirable characteristics of this material, including high strength and reduced weight. With respect to the material of the striking face, note that the '578 Patent claims are more specific than the instant claims and therefore include all of the instant, claimed features. Moreover, the selection of a specific material to take advantage of its properties in a particular application has been established in the Patent laws to be within the level of one of ordinary skill in the art. See In re Hopkins 145 USPQ 140. With the exception of the material differences set forth between the claims of the copending '578 Patent and the instant claims, the limitations in instant claim 1 closely parallel the verbiage used in claim 1 of the '578 Patent, while the limitations in instant claim 3 closely parallel the verbiage used in claim 8 of the '578 Patent. Thus, there would not appear to be any reason or benefit in further comparing the claim limitations at this time.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,669,578 in view of Peterson and Antonious. The '578 Patent in view of Peterson has been discussed above. To have further modified the claimed device in the '578 Patent to

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include a golf club head having the claimed height and width in order to provide an expanded hitting surface, which has become synonymous with the current state of the art of large metal woods would have been obvious in view of the patent to Antonious, which shows it to be old in the art to include a club head height of 2.0 inches and a club head width of 4.0 inches. See the table in col. 4 of Antonious, which details the dimensional parameters of the prior art clubs.

Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,648,773 in view of Peterson. The claims of the '773 Patent differ from the claims of the instant application in that the claims of the '773 Patent require a club body composed of plies of pre-peg material. In its broadest sense, the '773 Patent details a striking plate, though it is recognized that a mores specific recitation of the striking face insert as being made of a metal material selected from the group consisting of titanium, titanium alloy, steel alloys and amorphous metals is set forth in the Patent claims. The instant claims, on the other hand, require a body of non-metal material and do not specifically set forth the material make-up of the striking face. The teaching reference to Peterson details that the reinforced club head structure may be formed from any one of titanium, aluminum, stainless steel, composite or amorphous materials. See col. 4, lines 49-62 in Peterson. In view of the patent to Peterson, it would have been obvious to modify the claimed device of the '773 Patent by fashioning the body from any conveniently available material such as a non-metallic material to make use of the desirable characteristics of this material, including high strength and reduced weight.

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With respect to the material of the striking face, note that the '773 Patent claims are more specific than the instant claims and therefore include all of the instant, claimed features. Moreover, the selection of a specific material to take advantage of its properties in a particular application has been established in the Patent laws to be within the level of one of ordinary skill in the art. See In re Hopkins 145 USPQ 140. With the exception of the material differences set forth between the claims of the copending '773 Patent and the instant claims, the limitations in instant claim 1 closely parallel the verbiage used in claim 1 of the '773 Patent, while the limitations in instant claim 3 closely parallel the verbiage used in claim 9 of the '773 Patent. Thus, there would not appear to be any reason or benefit in further comparing the claim limitations at this time.

Claim 2 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,648,773 in view of Peterson and Antonious. The '773 Patent in view of Peterson has been discussed above. To have further modified the claimed device in the '773 Patent to include a golf club head having the claimed height and width in order to provide an expanded hitting surface, which has become synonymous with the current state of the art of large metal woods would have been obvious in view of the patent to Antonious, which shows it to be old in the art to include a club head height of 2.0 inches and a club head width of 4.0 inches. See the table in col. 4 of Antonious, which details the dimensional parameters of the prior art clubs.

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Enclosed with this Office action is a sample terminal disclaimer which is effective to overcome an obviousness-type double patenting rejection over a prior patent (37 CFR 1.1321(b) and (c)).

Also enclosed is a sample Statement Under 37 CFR 3.73(b) (Form PTO/SB/96) which an assignee may use in order to ensure compliance with the rule. Part A of the Statement is used when there is a single assignment from the inventor(s). Part B of the Statement is used when there is a chain of title. The "Copies of assignments..." box should be checked when the assignment document(s) (set forth in part A or part B) is/are not recorded in the Office, and a copy of the assignment document(s) is/are attached. When the "Copies of assignments..." box is checked, either the part A box or the part B box, as appropriate, must be checked, and the "Reel_____, Frame_____" entries should be left blank. If the part B box is checked, and copies of assignments are not included, the "From:_____ To:_____" blank(s) must be filled in. This statement should be used the first time an assignee seeks to take action in an application under 37 CFR 3.73(b), e.g., when signing a terminal disclaimer or a power of attorney.


All references cited during the prosecution of applicant's parent applications (10/064,810 and 10/064,434) are deemed pertinent to the examination of the instant claims and are incorporated herein by reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 703-308-1006. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
June 10, 2004

PTO/SB/28 (10-00)

Approved for use 10/31/2002, OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TERMINAL DISCLAIMER TO OBIVATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT	Docket Number (Optional)
<p>In re Application of: Application No.: Filed: For:</p> <p>The owner*, _____, of _____ percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. _____. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.</p> <p>In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.</p> <p>Check either box 1 or 2 below, if appropriate.</p> <p>1. <input type="checkbox"/> For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.</p> <p>I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.</p> <p>2. <input type="checkbox"/> The undersigned is an attorney or agent of record.</p> <div style="text-align: right; margin-top: 20px;"> _____ Signature </div> <div style="text-align: right; margin-top: 10px;"> _____ Date </div> <div style="text-align: center; margin-top: 20px;"> _____ Typed or printed name </div> <p><input type="checkbox"/> Terminal disclaimer fee under 37 CFR 1.20(d) included.</p> <p style="text-align: center;">WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</p> <p><small>*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.</small></p>	

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box Patent Application, Washington, DC 20231.

CERTIFICATE UNDER 37 C.F.R. § 3.73(b)

Applicant: _____

Application No.: _____ Filed: _____

For: _____

_____, a _____,
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.)

certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel _____, Frame _____, or for which a copy thereof is attached.

OR

B. ☐ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to act on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date : _____

Name : _____

Title : _____

Signature: _____